

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

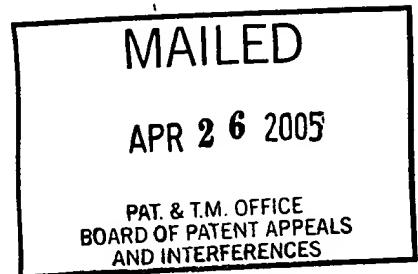
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHANIE GRASSO

Appeal No. 2005-0920
Application No. 09/892,527

ON BRIEF



Before GARRIS, PAK and WARREN, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1 through 11 and 13 through 19, which are all the claims pending in the above-identified application.

APPEALED SUBJECT MATTER

The subject matter on appeal is directed to a combination of an athletic footwear and a removable outersole having spikes and

a method of attaching the removable outersole having spikes to the athletic foot wear. Details of the appealed subject matter are recited in representative claims 1, 8 and 13, which are reproduced below:

1. A removable cleated outersole system comprising:

an athletic foot covering having a permanent substantially planar treaded bottom,

the treaded bottom having a toe portion, a heel portion, a perimeter side surface,

the perimeter side surface defining the perimeter shape of the permanent treaded bottom of the athletic foot covering;

a single elastically deformable band creating a continuous unbroken loop,

the band having an unbroken and continuous top edge and a bottom edge,

the bottom edge of the band being unbroken and formed in the shape of the perimeter shape of the permanent treaded bottom of the athletic foot covering;

a substantially planar unbroken sole surface coupled to the bottom edge of the band, the sole surface configured in the same perimeter shape and size of the permanent treaded bottom of the athletic foot covering, the sole surface sized to extend between the toe portion and the heel portion of the athletic foot covering,

the sole surface having a bottom side; and

a plurality of sport cleats protruding from the bottom side of the sole surface.

8. An athletic footwear system comprising:

a sneaker with a heel portion and a toe portion,

the sneaker having a permanent continuous treaded external sole with an outside perimeter edge;

the permanent treaded external sole being substantially planar;

a removable outersole having a single rigid planar unhinged sole plate, the sole plate being the same size and dimension as the permanent treaded external sole of the sneaker, the sole plate being uncovered,

the removable outersole covering the external sole and the sole plate being in direct contact with the treaded external sole of the sneaker,

the permanent treaded external sole of the sneaker adapted for use without the removable outersole,

a plurality of sport cleats protruding from the removable outersole; and,

a single unbroken continuous elastically deformable band secured to the entire perimeter of the removable outersole,

the elastically deformable band sized to removably secure the removable outersole to the permanent treaded sole.

13. A method of securing turf knobs to an athletic foot covering, the athletic foot covering being spikeless, having bottom treads, and a top, the method comprising:

stretching an elastically deformable unbroken and continuous band around the perimeter of the bottom treads of the athletic foot covering,

the elastically deformable band being shaped in the perimeter outline of the bottom treads of the athletic foot covering,

the elastically deformable band having an outersole secured to it, the outersole having a top surface and a bottom surface,

the outersole having a plurality of turf knobs protruding from it the turf knobs being integrally formed on the bottom surface of the outersole and having at least two different heights when measured from the bottom surface; and

releasing the elastically deformable band.

THE PRIOR ART REFERENCES

The prior art references relied upon by the examiner are:

Wilcox	Des. 105,159	Jun. 29, 1937
Folk	3,009,269	Nov. 21, 1961
Adair	3,643,352	Feb. 22, 1972
Carey	4,299,037	Nov. 10, 1981
Johnson	4,327,503	May 4, 1982
Bauer	4,377,042	Mar. 22, 1983
McNeil et al. (McNeil)	4,525,939	Jul. 2, 1985
Yavitz	5,600,902	Feb. 11, 1997
Mastrocola	5,615,495	Apr. 1, 1997
Smith	5,836,090	Nov. 17, 1998
Evans	6,032,386	Mar. 7, 2000

THE REJECTIONS

The appealed claims stand rejected as follows:

- 1) Claims 1, 5, 6 and 8 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Yavitz and Evans;
- 2) Claims 2 and 9 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Yavitz, Evans, Adair and Smith;
- 3) Claim 3 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Yavitz, Evans, Adair, Smith and either or both of McNeil and Carey;
- 4) Claim 4 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Yavitz, Evans and either Bauer, Folk or Mastrocola;
- 5) Claims 7, 10, 13, 17 and 19 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Yavitz, Evans and Johnson;
- 6) Claim 11 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Yavitz, Evans, Adair and either Bauer, Folk or Mastrocola;
- 7) Claims 14 and 15 under being 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Yavitz, Evans, Johnson and Smith;

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- 8) Claim 16 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Yavitz, Evans, Johnson, Smith and Adair; and
- 9) Claim 18 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Yavitz, Evans, Johnson and Wilcox.

OPINION

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the examiner and the appellant in support of their respective positions. This review has led us to conclude that the examiner's Section 103 rejections are not well founded. Accordingly, we will not sustain the examiner's Section 103 rejections for essentially those reasons set forth in the Brief and the Reply Brief. We add the following primarily for emphasis and completeness.

As our reviewing court stated in *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000):

Most if not all inventions arise from a combination of old elements. See *In re Rouffett*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* Rather, **to establish obviousness based on a combination of the elements**

disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 160 F.3d 1399, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). [Emphasis added.]

Here, we determine that the examiner has not identified any motivation, suggestion or teaching of the desirability of combining Yavitz with Evans, Adair, Bauer, Folk, Smith, McNeil, Carey, Mastrocola, Johnson and Wilcox to arrive at the claimed subject matter for the reasons set forth by the appellant at pages 4 through 6 of the Brief and page 2 of the Reply Brief. Specifically, we determine that the examiner has not demonstrated¹ that spikes or cleats, such as those taught by Evans and Johnson, are desirable or useful for the green protector of the type taught by Yavitz, i.e., protecting greens from the golf shoe spikes.² In this regard, we emphasize that Yavitz is directed to "articles for protecting greens on golf

¹ The examiner bears the initial burden of supplying a factual basis to support obviousness. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

² The examiner only relies on Yavitz, Evans, and Johnson to reject the broadest claims on appeal, independent claims 1, 8 and 13. The examiner relies on Adair, Bauer, Folk, Smith, McNeil, Carey, Mastrocola and Wilcox to show the limitations of the dependent claims on appeal.

courses from spike marks, and particularly to articles that can temporarily be placed along the soles of golf shoes to prevent penetration of the green's surface by the golf shoe spikes during putting." See column 1, lines 6-11.

Even if the spikes or cleats taught by Evans and Johnson can be combined with the green protector taught by Yavitz in the manner suggested by the examiner, such combination would not result in the claimed invention. As properly asserted by the appellant (Brief, pages 4-6), the combined teachings of Yavitz, Evans and Johnson do not suggest, *inter alia*, "the sole surface configured in the same perimeter shape and size of the permanent treaded bottom of the athletic foot cover . . ." recited in claims 1 and 8 and the "spikeless" athletic foot covering recited in claim 13.

Under the above circumstances, we determine that the examiner has not established a *prima facie* case of obviousness regarding the claimed subject matter. Accordingly, we are constrained to reverse the examiner's decision rejecting the claims on appeal under Section 103.

OTHER ISSUES

We note that Smith teaches a non-slip sandal which is adopted to be attached over shoes or boots to provide traction on

slippery or unwieldy surfaces. See column 1, lines 8-11. This non-slip sandal comprises "a soleplate **12**, sidewalls **14** integral with the soleplate and projecting upwardly therefrom, a strap assembly comprising a pair of foot straps **16, 16'** an ankle strap **20 . . .** replaceable studs **22** [spikes or cleats]." See column 2, lines 15-24. "The soleplate **12** is sized to accommodate the sole of a shoe and shaped generally to mimic the outline of the sole of the shoe." See column 2, lines 27-29. The sidewalls **14** "extend entirely around the periphery of the soleplate **12** and protrude upwardly normal to the upper surface of the soleplate **12**. The side walls **14** prevent a shoe engaged on the sandal from slipping laterally and longitudinally off the soleplate **12.**" See column 2, lines 35-41. It follows that Smith teaches a sandal corresponding the removable outersole recited in claim 1. Although Smith does not specifically mention the claimed athletic foot covering, such covering appears to be part of a conventional sneaker generally included in Smith.

Thus, upon return of this application, the examiner is to determine whether Smith, together with any prior art reference directed to a conventional sneaker having the claimed covering, would have rendered the subject matter of claim 1 and of its dependent claims obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103.

We also note that Adair teaches "a flexible, resilient overshoe of the kind which is stretched over an ordinary shoe, a plurality of spikes located within corresponding holes in the sole and heel portions of the overshoe respectively . . . and a full insole overlying the sole and heel pads." See column 1, lines 23-30. The insole of the overshoe is "contacted by the regular shoe of the wearer" and "extends over the whole of the inner part of the shoe, i.e., over both sole and heel regions and the arch region of the shoe," thus implying the insole surface corresponds to the shape and size of the regular shoe. See column 1, lines 60-63 and column 2, lines 37-40. The upper and outer soles of the overshoe are "flexible so that the overshoe can be stretched over a regular shoe and will be held firmly thereto." See column 1, lines 70-76. This overshoe can be used for playing golf or other sports. See column 1, lines 3-5. It follows that Adair teaches an overshoe corresponding to the

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removable outersole recited in independent claims 1 and 8 and a generic shoe inclusive of the claimed sneaker having the claimed athletic foot covering. Although Adair does not mention any particular shoes, such as the claimed sneaker having the claimed athletic foot covering, such sneaker appears to be conventional.

Thus, upon return of this application, the examiner is to determine whether Adair, together with any prior art reference directed to a conventional sneaker having the claimed covering, would have rendered the subject matter of claims 1 and 8 and any of their dependent claims obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103.

We also note that Johnson teaches various advantages of employing the cleats or spikes recited in claim 13 in sports shoes. See, e.g., columns 1 and 2. It then logically follows that one of ordinary skill in the art would have been led to employ the cleats or spikes of the type discussed in Johnson as the spikes or cleats of the overshoe described in Adair, motivated by a reasonable expectation of obtaining the advantages enumerated at columns 1 and 2 of Johnson.

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Thus, upon return of this application, the examiner is to determine whether Adair and Johnson, together with any prior art reference directed to a conventional sneaker having the claimed covering, would have rendered the subject matter of claims 1, 8 and 13 and any of their dependent claims obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103.

CONCLUSION

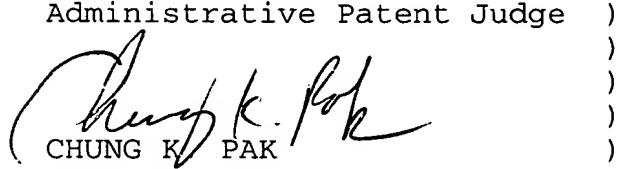
In view of the foregoing, we reverse the examiner's Section 103 rejections and remand the application to the examiner to take appropriate action consistent with the instruction set forth above.

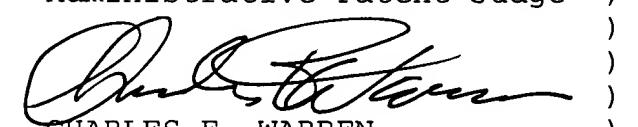
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This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is **not** made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) does not apply.

REVERSED/REMANDED


BRADLEY R. GARRIS)
Administrative Patent Judge)


CHUNG K. PAK)
Administrative Patent Judge)


CHARLES F. WARREN)
Administrative Patent Judge)

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BOARD OF PATENT
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